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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Yoshizumi Mano

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT

PAPER NUMBER

3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/001,766

Applicant(s)

MANO ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. Applicant's election without traverse of claims 1-9 in the reply filed on 11/13/06 is acknowledged.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 7,8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For claims 7,8, the examiner does not see how the claimed method results in a tangible result. The result of the claim is an "attachment" of the rights indicated by right information to the program content. This is not resulting in anything that can be considered as real world and tangible. The attachment of a right to the program content is akin to the granting of rights to an individual or an entity. This does not product any kind of tangible result because a granting of rights for the content is intangible and is more of a concept or an abstract idea. The claims do not provide a tangible result and for this reason are not considered to be statutory.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 1, it is not clear as to what the scope of some of the means plus function language is (112,6th). Claim 1 recites a 1st and 2nd input means that function to receive data via a network. It is not clear to the examiner what structure each of the recited "input means" is supposed to have. How does the 1st input means differ structurally from the 2nd input means? Taking into consideration the function that is recited, it seems to the examiner that structurally, the input means that allows data to occur is the same regardless of who is sending the data that is to be received. What is the corresponding structure from the specification that is covered by the language 1st and 2nd input means, and further, how do the 1st and 2nd input means differ from each other structurally? This is not clear and one wishing to avoid infringement would not understand what the scope of the claim is, so the claim is indefinite.

For claims 3,4, the same problem is present that is found in claim 1, namely that it is not clear how the 3rd input means differs from the 1st and 2nd input means, and it is not clear as to what the corresponding structure is from the specification that is covered by the 3rd input means recitation? This is not clear. The same applies to the 4th input means, how is this means different from any of the 1st, 2nd, or 3rd input means? Also, for claim 4, how is the 2nd recording means different from the 1st recording means? What structure is covered by each of the 1st and 2nd recording means? This is not clear.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 7,8 are rejected under 35 U.S.C. 102(b) as being anticipated by the well known prior art act of selling the broadcast rights for a television program to a broadcaster (CBS, ABC, etc.) as has been done for years with "syndicated television programming". The examiner takes "official notice" that this method was on public use more than one year prior to the filing date of the instant application (in support of this position the examiner has cited an article entitled "Syndication").

For claims 7,8, when the rights to broadcast a television program are bought, it is inherent that information concerning the content (what kind of program) and the broadcasting rights (what are the actual specific broadcast rights being sold) associated with the content would be received. When the rights are purchased, this is the same as attaching the right to broadcast the program to the content itself. Claim 7 uses no technology and is more or less reciting the old and well-known prior art act of purchasing the broadcast rights to broadcast a particular television program, which is disclosed by the cited reference.

8. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferstenberg et al. (5873071).

For claim 1, Ferstenberg discloses a system and method for the sale of commodities. Ferstenberg discloses an intermediary system 40 (a computerized system; i.e. a server) that allows buyers and seller of a commodity to interact and negotiate with each other concerning the purchase of the commodity. The intermediary system receives information from sellers of commodities and allows buyers to view the information received from sellers. The commodity that is being sold can be anything from stocks and bonds to tangibles such as copper or soy beans, see column 1, lines 14-25. Ferstenberg discloses that there are seller computers and buyer computers, which are the client systems disclosed in column 39. Each client system is connected via a network to intermediary system 40. The claimed first input means is considered to be the hardware and software that the system 40 would necessarily be required to have so that data can be received from a seller. This can be a modem and the software that allows data to be received. The intermediary system 40 inherently has an input means. It must have an input means so that the system can receive data from the sellers and buyers of various commodities as disclosed by Ferstenberg. The first recording means is considered to be the database of the system 40 and the software that controls the saving of data. This is also inherent to the system 40. The claimed output means is the hardware and software that allows system 40 to send out communications to the clients. For system 40 to be able to send communications to the client systems, an output means is necessarily required. The second input means (as best understood by the

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examiner) is also satisfied by the hardware and software that the system 40 would necessarily be required to have so that data can be received from a buyer of the commodity. This can be a modem and the software that allows data to be received from the buyer. The assisting means that "assists" the buyers and sellers in conducting the transaction is considered to be the hardware and software that allows the negotiation between the seller and buyer to occur. When messages are exchanged regarding the commodity, this satisfies the claimed "assisting means". With respect to the fact that claim 1 is reciting that the information received is concerning "program content", this has been considered but as far as the system goes, this defines nothing to the system that is not found in Ferstenberg and is directed to the intended use of the system. This is because the commodity that is being sold is not part of the system and claiming a specific commodity does not change the overall system. Because Ferstenberg can be used with any kind of commodity and because the system is what is being claimed in claim 1 (not the method), Ferstenberg anticipates what is claimed. The recitation that it is "program content" that is being sold, does not result in a structurally different system from that of Fersternberg.

For claim 2, the negotiation aspect of Ferstenberg results in the formation of data corresponding to a document (the sales contract) regarding the sale of the commodity. The language "data corresponding to a document " is very broad and includes just about any kind of data.

For claim 3, as best understood by the examiner the 3rd input means is satisfied by the input means discussed with respect to claim 1. It is also considered inherent to

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Ferstenberg that there is a "search means" that will search for matching information that matches the information submitted from the buyer. This is necessarily present in Ferstenberg because when a buyer submits an order for a particular commodity, the system 40 must have some way of determining what clients can satisfy the order desired by the buyer. This is how the matching of a selling client to a buying client happens. The output means as best understood by the examiner is satisfied by the output means discussed with respect to claim 1. The system 40 cannot assist in the conducting of a transaction if it cannot be determined who has offered a particular commodity for sale that a buyer has expressed an interest in purchasing.

For claim 4, as best understood by the examiner, the 3rd and 4th input means are satisfied by the input means discussed with respect to claim 1. The system 40 stores information concerning the sellers and buyers that interact with system 40.

For claim 5, this claim is reciting nothing further structurally to the system of claim 1. This is because the "program rights" are not a structural part of the system. The rights are just what the system is used to sell. Additionally, "rights" are not even a real world tangible thing that can be claimed, so the examiner cannot possibly give weight to what is claimed. A "right" is not a real world thing, but is more of an intangible thing.

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9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferstenberg et al. (5873071).

For claims 6-9, Ferstenberg discloses a system and method for the sale of various commodities. Ferstenberg discloses an intermediary system 40 (a computerized system; i.e. a server) that allows buyers and seller of a commodity to interact and negotiate with each other concerning the purchase of the commodity. The intermediary system receives information from sellers of commodities and allows buyers to view the information received from sellers. The commodity that is being sold can be anything from stocks and bonds to tangibles such as copper or soy beans, see column 1, lines 14-25. Ferstenberg discloses that there are seller computers and buyer

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computers, which are the client systems disclosed in column 39. Each client system is connected via a network to intermediary system 40. The claimed first input step is considered to be satisfied by the fact that data is received from a seller regarding what commodities are for sale (column 17, lines 51-63). This information is recorded as claimed. The claimed output step is the sending of information to the buyer. This would be information regarding what the seller is selling and would be notification to the buyer that a transaction may be able to be made. The second input step is the receiving of the "objectives and constraints" from the buyer (column 17, lines 51-63). The assisting step that "assists" the buyers and sellers in conducting the transaction is considered to be the execution of the software that allows the negotiation between the seller and buyer to occur. This happens by the sending of messages from the buyer to seller and from seller to buyer (offers and counteroffers). When messages are exchanged regarding the commodity, this satisfies the claimed "assisting step". With respect to the fact that claim 1 is reciting that the information received is concerning "program content", this is not disclosed by the prior art. Because it is disclosed that the commodities can be stocks and bonds, or real world tangible goods (copper), one of ordinary skill in the art would have recognized that the system of Ferstenberg could be used for the selling and buying of any kind of commodity. Because it is very well known in the art that "program content" (broadcasting rights of some kind of media content) is sold by "content producers" and that content is purchased by "broadcasters", one of ordinary skill in the art at the time the invention was made would have found it obvious to use the system of Ferstenberg for the sale and purchase of television programming

rights. This is just using the Ferstenberg for another type of commodity that is widely recognized as already being bought and sold by those involved in television and the media.

For claim 7 in addition to that above, when a program is sold by using the system of Ferstenberg, this is "attaching" the "right" to broadcast the purchased program to the content itself. When a buyer negotiates the purchase of program content by using the system of Ferstenberg, and a sale is made, this is a granting of the "right" for the buyer to broadcast the purchased program. This satisfies what is claimed.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The article "Syndication" describes what syndicated programming is and is cited as supporting evidence in support of the examiner's taking of official notice.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER